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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/592,921

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EXAMINER

KENNEDY, NICOLETTA

ART UNIT

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4131

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/592,921	Applicant(s) GILES ET AL.	
	Examiner NICOLETTA KENNEDY	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).\

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 provides for the use of the composition in claim 1 to improve the condition of the hair, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadlock et al. (US 2004/0115159 A1) read in view of Minegishi et al (US 4,102,795). Tadlock et al. teach a pharmaceutical product for hair that contains at least one cationic surfactant and an amphoteric surfactant (Abstract, paras. 12 and 17).

With regard to claim 1, Tadlock et al. teach the inclusion of at least one cationic surfactant and an amphoteric surfactant in a hair care composition (Abstract, paras. 12 and 17). Specifically, Tadlock et al. teach that the cationic surfactant can be a quaternary ammonium wherein the long chain alkyl group has from about 8 to about 22 carbon atoms (para. 13). Tadlock et al. then provides cetyl trimethyl ammonium chloride and cetrimonium bromide and chloride as examples (para. 13). An additional cationic surfactant can have from about 12 to about 22 carbons and suitable salts include halogen, acetate, phosphate, nitrate, citrate, and lactate (para. 14) An example of such a surfactant is dihydroxy ethyl stearylamine (para. 14). Tadlock et al. teach that the amphoteric surfactant can be an imidazoline (para. 17). The total weight of surfactants in the composition ranges from about .5% to 5.5% (claim 17 and example 1).

Tadlock et al. do not teach the specific percentages that Applicants disclose in the claimed invention. Nor do Tadlock et al. specifically teach a *dialkyl* imidazoline or a compound having the *exact* formula disclosed in claim 1(c). As to the specific percentages not being taught, Tadlock et al. do teach a total surfactant percentage of 5.5% (claim 17). The total possible weight of composition disclosed in the claimed invention is 6.5% (5% from claim 1(a), 1% from claim 1(b), and .5% from claim 1(c)). Given the fact that Tadlock et al. claims “about” 5% and because there is such a variety

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of possible percentages in the claimed invention, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to use surfactants in a hair care composition where the surfactants comprised a maximum of 6.5% of the total weight of the composition. This reasoning applies to claims 2-4 as well.

This position is further supported in the MPEP, section 2144.05. The section reads, in pertinent part:

Similarly, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

As to the specific compounds of claim 1(b) and 1(c) not being taught, Tadlock et al. does disclose specific compounds *by way of example only* and states that any cationic or anionic surfactant known in the art may be used (para. 13). However, Minegishi et al. teach a hair care composition comprising imidazoline-based quaternary compounds where two alkyl groups have between 11 and 24 carbon atoms (column 2, lines 30-49). Therefore, the compound in claim 1(b) is was known in the art at the time of the invention. Additionally, Luviquat Mono CP, a compound disclosed by Applicants as being a preferred compound fitting the formula disclosed in claim 1(c), has been known in the art as a quaternary ammonium salt as hair conditioner, emulsifying agent, and solubilizer, since at least 1993 (see Luviquat technical information). Because the compounds/formulas in claims 1(b) and 1(c) were known in the art at the time of

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Tadlock et al.'s invention, it would have been obvious to a person of ordinary skill in the art that compounds fitting the formula disclosed in claims 1(b) and 1(c) could be used as amphoteric and cationic surfactants, respectfully.

With regard to claim 5, Tadlock et al. teach the inclusion of a solubilizer, such as an alcohol (mono- or polyhydric) or a fatty acid polyglycerol ester (paras. 19-20).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used a fatty alcohol, fatty acid, or alkoxylated fatty alcohol in the composition.

With regard to claim 6, Tadlock et al. additionally teach the inclusion of purified water at 59.40% and 53.90% (examples 1 and 2). Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used water comprising 50% or more by weight of the total composition.

With regard to claims 7 and 9, Tadlock et al. teach the inclusion of volatile oils including silicones or straight or branched chain hydrocarbon (para. 7). Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have included a silicone or hydrocarbon oil in the composition.

With regard to claim 8, Tadlock et al. do not teach the inclusion of a hydrophobically modified clay. However, Minegishi et al. do teach the inclusion of a hydrophobically-treated clay, specifically betonites, as a suspending/antiagglomerating agent for the hair care composition (column 14, lines 11-39). Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have

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included a hydrophobically treated clay in a composition, especially in one that contains silicone.

With regard to claims 10-11, Tadlock et al. disclose a product for application to the hair (Abstract). Further, Tadlock et al. disclose the addition of a variety of ingredients, such as hair conditioners and hair treatment agents (para. 21). Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used this composition to improve the condition of the hair and to use the composition as a hair conditioner by applying it to the hair.

Conclusion

No claim is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLETTA KENNEDY whose telephone number is (571)270-1343. The examiner can normally be reached on Monday through Thursday 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/NICOLETTA KENNEDY/
Patent Examiner, Art Unit 4131**

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**